Patent / Docket No. 26530.18 (IDR-445)
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# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re application of:<br>    Daniel Burton, et al. | §<br>§<br>§ | Group Art Unit: 2143 |
| Serial No.  09/685,238 | §<br>§ | |
| Filed:  October 10, 2000 | §<br>§ | Examiner:  Arrienne M. Lezak |
| For:  System and Method for Sharing Files<br>    Via a User Internet File System | §<br>§<br>§ | |

## TRANSMITTAL

Mail Stop  APPEAL BRIEFS-PATENT
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed are the following regarding the above-identified patent application:

1.    Brief of Appellant w/Appendix (in triplicate);

2.    Check in the amount of $500.00; and

3.    Return Post Card.

The Commissioner is hereby authorized to charge payment of any further fees associated with any of the papers submitted herewith or to credit any overpayment to Deposit Account No. 08-1394.

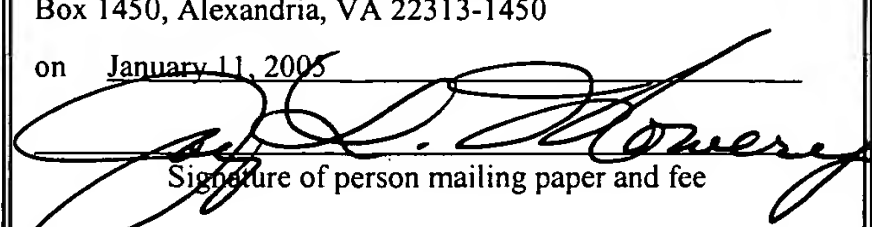Respectfully submitted,

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Date: __Jan. 11, 2005__

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| Filed:  October 10, 2000 | §<br>§ | Examiner: Arrienne M. Lezak |
| For:    SYSTEM AND METHOD<br>       FOR SHARING FILES<br>       VIA A USER INTERNET<br>       FILE SYSTEM | §<br>§<br>§<br>§<br>§ | |

## BRIEF OF APPELLANT

Mail Stop:  APPEAL BRIEFS-PATENT
Commissioner For Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Brief is submitted in connection with an appeal from the final rejection of the Examiner dated July 9, 2004, finally rejecting claims 1-34, all of the pending claims in this application. Two additional copies of this Brief are submitted herewith.

## REAL PARTY IN INTEREST

The real party in interest is Novell, Inc., a Delaware company having a principal place of business at 122 East 1700 South, Provo, Utah, 84606, United States of America.

## RELATED APPEALS AND INTERFERENCES

There are no related appeals and no related interferences regarding the above-identified patent application.

## STATUS OF CLAIMS

The present application was filed on October 10, 2000. The patent application contained claims 1-34, of which claims 1, 8, 18, 25, 28, 29, 32, and 34 are independent claims. Claims 1-34 are pending and stand finally rejected. These pending claims are on appeal here and are set forth in the Appendix attached hereto.

## STATUS OF AMENDMENTS

A Response was filed in response to the Final Office Action dated July 9, 2004. This Response did not amend any of the claims. An Advisory Action dated November 12, 2004 was issued in response to the Response and did not deem any of the claims allowable.

## SUMMARY OF THE INVENTION

The present invention, in one embodiment as now set forth in independent claim 1, relates to a method for configuring an internet file system. Referring generally to Fig. 1 unless otherwise specified, the claimed method comprises accessing, by a user, a server (18) that is configured with an application (20) (page 4, lines 16 and 17); creating, by the application (20), an internet file system (26) for the user (page 4, lines 16 and 17); storing, by a directory (24), a home folder (28) of the user, wherein folders and files in the home folder (28) are available at a root of the internet file system (26) (page 4, lines 18-19 and 23-24); providing, by the application (20), a first folder (40) and a second folder (42) in a root of the home folder (28), the first folder (40) containing folders that represent folders and files that have been shared with the user, and the second folder (42) containing objects of the user and communities that are of interest to the user (page 4, lines 24-27 and page 5, lines 1-12); and creating, by the application (20), an auxiliary class (30) containing a first attribute (32), a second attribute (34), and a third attribute (36), wherein the first attribute (32) is used to quickly find other users that the folders and the files in the home folder (28) have been shared with, the second attribute (34) is used to store names of the other users and a path of the folders and the files that have been shared with the user, and the third attribute (36) is used to allow the user and other users with common interests to share folders and files of the common interest (page 5, lines 19-26).

Another embodiment, as set forth in independent claim 8, relates to a method for file sharing. Referring generally to Fig. 2 unless otherwise specified, the method comprises sharing, by a first user (User A 50), a file with a second user (User B 52) (page 5, lines 27 and 28); adding, by an application (Fig. 1, element 20), the first user (User A 50) to a third attribute (54) of the second user (page 5, lines 27-29); adding, by the application (20), the second user (User B 52) to a third attribute (36) of the first user (User A 50) (page 5, line 29); adding, by the application (20), a path of the shared file and a user name of the second user (User B 52) to a first attribute (32) of the first user (User A 50) (page 6, lines 1 and 2); adding, by the application (20), the path of the shared file and a user name of the first user (User A 50) to a second attribute (56) of the second user (User B 52) (page 6, lines 2 and 3); and making available, by the application (20), the first attribute (32) through a folder (Fig. 1, element 40) of the second attribute (56), wherein the folder (Fig. 1, element 40) belongs to the second user (User B 52) (page 6, lines 3 and 4).

Another embodiment, as set forth in independent claim 18, relates to a method for creating user objects in a directory. Referring generally to Fig. 3, the method comprises if a user shares a folder with another user who is not registered with an application (Fig. 1, 20) in the directory (24), creating a temporary user object (70) with an email address as a name of the another user (page 6, lines 24-26); submitting, by the another user, a registration form (62) (page 6, line 26); determining, by a script (66), if the email address corresponds with the another user (page 6, lines 26 and 27); and if the email address corresponds with the another user, updating the temporary user object (70) based on information provided in the registration form (62) (page 6, lines 27 and 28).

Another embodiment, as set forth in independent claim 25, relates to a system for configuring an internet file system. Referring generally to Fig. 1 unless otherwise noted, the system comprises a server (18) configured with an application (20) (page 3, lines 16 and 17), wherein a user accesses the application (20) and the application (20) creates an internet file system (26) for the user (page 4, lines 16 and 17); and a directory (24) that stores a home folder (28) of the user, wherein folders and files in the home folder (28) are available at a root of the

internet file system (26) (page 4, lines 18-19 and 23-24), wherein the application (20) further provides a plurality of folders in a root of the home folder (28), and wherein the application (20) further creates an auxiliary class (30) containing a plurality of attributes (32, 34, and 36) (page 5, lines 19-26).

Another embodiment, as set forth in independent claim 28, relates to a system for file sharing. Referring generally to Fig. 2 unless otherwise noted, the system comprises means for sharing, by a first user (User A 50), a file with a second user (User B 52) (page 5, lines 27 and 28); means for adding, by an application (Fig. 1, element 20), the first user (User A 50) to a third attribute (54) of the second user (User B 52) (page 5, lines 27-29); means for adding, by the application (20), the second user (User B 52) to a third attribute (36) of the first user (User A 50) (page 5, line 29); means for adding, by the application, a path of the shared file and a user name of the second user (User B 52) to a first attribute (32) of the first user (User A 50) (page 6, lines 1 and 2); means for adding, by the application (20), the path of the shared file and a user name of the first user (User A 50) to a second attribute (56) of the second user (User B 52) (page 6, lines 2 and 3); and means for making available, by the application, the first attribute (32) through a folder (Fig. 1, element 40)of the second attribute, wherein the folder (Fig. 1, element 40) belongs to the second user (User B 52) (page 6, lines 3 and 4).

Another embodiment, as set forth in independent claim 29, relates to a user internet file system. Referring generally to Fig. 1 unless otherwise noted, the system comprises a received folder (40) that contains folders representing files and folders that have been shared with a user and the names of those who shared the files and folders with the user; and a friends folder (42) that contains the user's objects and community folders that contain information that are of interest to the user (page 4, line 24-27; page 5, lines 1-14).

Another embodiment, as set forth in independent claim 32, relates to a directory (24). Referring generally to Figs. 1 and 3 unless otherwise noted, the directory (24) comprises a user object (27 or 70); a home folder (28) of the user, wherein the home folder (28) is an attribute of the user object (27 or 70) (Fig. 1; page 4, lines 5 and 6; page 5, lines 7-11); an auxiliary class (30) attached to the user object (27 or 70) when files are shared with the user (Fig. 1) (page 5, lines 12-14); a community folder that includes topics of interest to the user (page 5, lines 4-8); and a group object (72) associated with each topic of interest (62b) (page 6, line 30-page 7, line 3).

Another embodiment, as set forth in independent claim 34, relates to a software application executable on a computer. Referring generally to Fig. 1 unless otherwise noted, the application comprises creating a user internet file system (26) (page 4, lines 16 and 17); providing files in a root of a user's home folder (28) (page 4, lines 18-19 and 23-24); and creating an auxiliary class (30) attached to an object (27 or 70 in Fig. 3) of the user if the files are shared via the internet file system (26) (page 5, lines 12-14).

## ISSUES

1.      Whether claims 29-31 are unpatentable under 35 U.S.C. §102(e) over U.S. Patent No. 6,351,776 to O'Brien ("O'Brien").

2.      Whether claims 1-3, 8, 11-17, 19, 20, 25-28, and 32-34 are unpatentable under 35 U.S.C. §103(a) over O'Brien and U.S. Patent No. 6389589 to Mishra ("Mishra").

3.      Whether claims 4-7, 9, 10, 18, and 21-24 are unpatentable under 35 U.S.C. §103(a) over O'Brien and Mishra and further in view of *Role-Based Access Control* by David Ferraiolo and Richard Kuhn of the National Institute of Standards and Technology for the Proceedings of 15th National Computer Security Conference, 1992 ("Ferraiolo").

## GROUPING OF CLAIMS

As to the rejection of claims 1-7 it is Applicants' intention that solely for the purposes of this appeal, these rejected claims stand or fall together.

As to the rejection of claims 8-17, it is Applicants' intention that solely for the purposes of this appeal, these rejected claims stand or fall together.

As to the rejection of claims 18-24, it is Applicants' intention that solely for the purposes of this appeal, these rejected claims stand or fall together.

As to the rejection of claims 25-27, it is Applicants' intention that solely for the purposes of this appeal, these rejected claims stand or fall together.

As to the rejection of claims 28, it is Applicants' intention that solely for the purposes of this appeal, this rejected claim stand or fall together.

As to the rejection of claims 29-31, it is Applicants' intention that solely for the purposes of this appeal, these rejected claims stand or fall together.

As to the rejection of claims 32 and 33, it is Applicants' intention that solely for the purposes of this appeal, these rejected claims stand or fall together.

As to the rejection of claims 34, it is Applicants' intention that solely for the purposes of this appeal, this rejected claim stand or fall together.

## ARGUMENT

### Issue 1.

The first issue for the Board's consideration is whether claims 29-31 are unpatentable under 35 U.S.C. §102(e) over O'Brien. MPEP § 2131 provides that "[t]o anticipate a claim, the reference must teach **every element** of the claim...." (emphasis added). However, O'Brien neither teaches nor shows all of the limitations in independent claim 29, which cites:

29.    A user internet file system comprises:
a received folder that contains folders representing files and folders that have been shared with a user and the names of those who shared the files and folders with the user; and
a friends folder that contains the user's objects and community folders that contain information that are of interest to the user.

Claim 29 teaches a received folder and a friends folder. The received folder "contains folders representing files and folders that have been shared with a user and the names of those who shared the files and folders with the user." This is depicted in Fig. 1, where received folder 40 includes, for example, a collection of User 1 and User 1's folders that User 1 has chosen to share with the present user, User 2 and User 2's folders that User 2 has chosen to share with the present user, etc. In other words, in this received folder are things that *other people are sharing with the user*.

O'Brien is devoid of any mention of any mechanism of this received folder. As support for the rejection, the Examiner repeatedly referenced the Abstract, FIG. 13, Col. 20, lines 21-52 of O'Brien. None of these locations referenced by the Examiner teaches the claim. The Abstract talks generally about "Internet-based file storage, retrieval, access, control, and manipulation for a user" and using password protection of a user's account. FIG. 13 depicts "a Windows™ desktop display showing both the client and web-browser applications" (Col. 5, lines 14-15) and an X:drive that includes a private and a public folder icons. The text in Col. 20 references FIG. 13 and "directory structures of web-based application window 1350 and the client-based application window 1320." In fact, a careful examination of the 14 drawing figures and 20 columns of text of the entire O'Brien reference does not yield any discussion of the limitations of claim 29.

As set forth in the Background section of the patent application, systems such as O'Brien "typically use databases to store information about users and the rights of those users to certain files in a system. As such, anytime a user attempts to access a particular file, a database check will be made to determine if the user has rights to that file. Constantly using a database to allow file sharing between users can become a cumbersome exercise." (Page 2, lines 24-28). It is apparent that O'Brien uses such conventional methods  in addition to the use of "[p]assword

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protection or other security protocols ... to limit or discriminate access to the user's files," (col. 4, lines 3-6; see also Abstract) but does not teach a received folder that contains the names of other people who are sharing data with the current user.

The Examiner further relies on an apparently self-authored general statement that "all the access rights of a received folder correspond to the well-known access rights of a private folder" (Paper 6, page 12, paragraph 33) in support of the rejection. Applicants respectfully submit that there is a lack of basis for this statement or if there is one, the Examiner has not shared it with Applicants (The Examiner did not explicity take Official Notice for this "well-known" information but acted like she did). The Examiner seemingly pulled "private folder" out of thin air. Only after a careful examination of O'Brien does one see that FIG. 13 of O'Brien shows a folder icon labeled with the word "private" in its X:Drive. Because O'Brien is entirely silent as to what is a "private folder," we are forced to look to conventional definitions. A "private" folder, by definition, has limits on its access to keep the contents of the folder private. See for example, the *Merriam-Webster Online Dictionary*, which defines "private" as:

> 1 a : intended for or restricted to the use of a particular person, group, or class <a *private* park> b : belonging to or concerning an individual person, company, or interest <a *private* house>.

Therefore, the private folder is a folder containing items that a user or administrator has established, for other users, certain limits on access. Nowhere in O'Brien does it teach that the private folder "contains folders representing files and folders that have been shared with a user and the names of those who shared the files and folders with the user." The Examiner's general statement also mentioned "access rights to a private folder." This phrase may be broadly read as an indication of persons that can access the folder, or a requirement to gain access to the folder (such as a password). However, there is simply no similarity between claim 29 and a "private folder."

Independent claim 29 also teaches "a friends folder that contains the user's objects and community folders that contain information that are of interest to the user." The Examiner, again relying on a folder icon labeled "public" in Fig. 13 of O'Brien, formulated the statement that, "all the access rights of a friends folder correspond to the well-known access rights of a public

folder." Applicants respectfully disagree. The friends folder is not similar or equivalent to a "public folder." The term "public," by definition, does not have any restriction of access. The Examiner's "public folder," as may be known pursuant to the definition of "public," contains data that a user allows other users to access without limitation. This does not describe the friends folder.

It is clear that O'Brien does not teach in any manner or form the elements of claim 29. It is well-established that "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Unio Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). It is impermissible to make the quantum leap from an Internet-based file storage system disclosed by O'Brien and the mere depiction of two folder icons to the claimed limitations without any teaching or suggestion. (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) ("The identical invention must be shown in *as complete detail as is contained in the claim*." (emphasis added)). In fact, nothing in O'Brien can even be bent or twisted to provide a teaching of the received folder and friends folder in claim 29. Therefore, this rejection is not supported by the O'Brien and must be withdrawn.

Applicants further respectfully disagree with the Examiner's statement in the Advisory Action that "Examiner reminds Applicant's Attorney that focusing on the public/private scope of the limitations strictly regards directed use, which directed use is not a patenable distinction." It was the Examiner who initially brought up the terms "private" and "public" and attempted to characterize the received folder and the friends folder as private and private folders with their respective access rights. Applicants at all times focused on the limitations of claim 29, which are: "a received folder that contains folders representing files and folders that have been shared with a user and the names of those who shared the files and folders with the user; and a friends folder that contains the user's objects and community folders that contain information that are of interest to the user." Applicants respectfully submit to the Board that the above limitations are not "directed use" but describe what **is** the received folder and friends folder.

Claim 29 has two dependent claims 30 and 31 that are also patentable over O'Brien for at least the same reasons set forth above.

## Issue 2.

The second issue is whether claims 1-3, 8, 11-17, 19, 20, 25-28, and 32-34 are unpatentable under 35 U.S.C. §103(a) over O'Brien and Mishra. This issue will be discussed with specific reference to each independent claim below. The independent claims so rejected are claims 1, 8, 25, 29, 32 and 34.

## Claim 1

Independent claim 1 stands rejected under 35 U.S.C. § 103(a) over O'Brien and Mishra. Applicants again traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1. It is well settled that, in order to reject a patent application for obviousness, the prior art reference must teach or suggest all of the claimed limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Applicants respectfully submit that even if properly combined, O'Brien and Mishra clearly do not teach or suggest the limitations of claim 1.

Claim 1 cites,

> 1.    A method for configuring an internet file system, the method comprising:
>         accessing, by a user, a server that is configured with an application;
>         creating, by the application, an internet file system for the user;
>         storing, by a directory, a home folder of the user, wherein folders and files in the home folder are available at a root of the internet file system;
>         providing, by the application, a first folder and a second folder in a root of the home folder, the first folder containing folders that represent *folders and files that have been shared with the user*, and the second folder containing *objects of the user and communities that are of interest to the user*; and

creating, by the application, an auxiliary class containing a first attribute, a second attribute, and a third attribute, wherein the first attribute is used *to quickly find other users that the folders and the files in the home folder have been shared with*, the second attribute is used to store *names of the other users* and a *path of the folders and the files that have been shared with the user*, and the third attribute is used to *allow the user and other users with common interests to share folders and files of the common interest*. (emphasis added)

The MPEP § 2142 provides:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness.

### a.     Alone or Combined, the References Do Not Teach the Claimed Subject Matter

O'Brien and Mishra cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the <u>subject</u> <u>matter</u> <u>as</u> <u>a</u> <u>whole</u> would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, <u>all</u> <u>limitations</u> <u>of</u> <u>the</u> <u>claim</u> <u>must</u> <u>be</u> <u>evaluated.</u> Contrary to the Examiner's assertion, O'Brien does not teach, for example, "the first folder containing folders that represent *folders and files that have been shared with the user*, and the second folder containing *objects of the user and communities that are of interest to the user*," (emphasis added) but merely provides a database that may be searched for Internet-based files. The Examiner repeatedly relied generally on the Abstract, Fig. 13, col. lines 21-42 for support of this rejection. However, these locations in O'Brien do not show or describe the first and second folder limitations of claim 1.

Applicants respectfully submit that Mishra does not teach or suggest "creating, by the application, an auxiliary class containing a first attribute, a second attribute, and a third attribute, wherein the first attribute is used to quickly find other users that the folders and the files in the home folder have been shared with, the second attribute is used to store names of the other users and a path of the folders and the files that have been shared with the user, and the third attribute is used to allow the user and other users with common interests to share folders and files of the common interest." The Examiner, in support of her assertion that Mishra does provide such teaching, referenced generally the text in col. 4, line 63 to col. 6, line 13 of Mishra. In connection with this, the Examiner believed that since Mishra teaches "the implementation of a class store in a group policy for purposes of application management utilizing the Windows NT Active Directory and a LDAP class store schema," it naturally follows that Mishra teaches claim 1. However, a careful examination of the referenced text and even the entire text of Mishra does not yield the claimed limitations. Mishra, either alone or in combination with O'Brien, is devoid of any teaching or suggestion of a first attribute of an auxiliary class that is indicative of "other users that the folders and the files in the home folder have been shared with," a second attribute of the auxiliary class that is indicative of "names of the other users and a path of the folders and the files that have been shared with the user," and a third attribute of the auxiliary class that allows "the user and other users with common interests to share folders and files of the common interest."

Therefore, the combination of O'Brien and Mishra does not render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute are not met.

**b.      Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness**

O'Brien teaches that a "X:Drive system 100 stores file metadata (such as directory structure, file name, file attributes, etc.) in the database 152 for fast retrieval, sorting, searching, linking, and other capabilities beyond standard file systems" (Col. 11, line 66 to Col. 12, line 2). Because O'Brien does not teach the first, second and third attributes as set forth in claim 1 and further teaches away from these limitations of claim 1, O'Brien cannot be properly used to establish obviousness for the purpose of the rejection. O'Brien teaches a method of searching for

files away from "the first attribute ...used to quickly find other users that the folders and the files in the home folder have been shared with, the second attributed...used to store names of the other users and a path of the folders and the files that have been shared with the user." In addition, O'Brien's teaching of using "databases to store information about users and the rights of those users to certain files in a system. As such, anytime a user attempts to access a particular file, a database check will be made to determine if the user has rights to that file." (Page 2, lines 24-25) teaches away from the claimed invention. Such conventional access right determination is discussed in the Background portion of the present application (page 2, last full paragraph). Further, O'Brien repeatedly mentions the use of passwords or permissions to limit access to files (e.g. Abstract; col. 4, lines 2-6). Accordingly, the combination of O'Brien with Mishra teaches away from the claimed invention.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 1 under 35 U.S.C. §103 should be withdrawn.

### c.     The Combination of References is Improper

Applicants respectfully submit to the Board that O'Brien and Mishra cannot be properly combined to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

> *...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Neither O'Brien nor Mishra teaches, or even suggests, the desirability of the combination as neither reference even teach the claimed elements in claim 1.

The MPEP further provides at § 2143.01:

> *The mere fact that references **can be combined or modified** does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.* (emphasis added)

Courts have also repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The Examiner supplied the motivation to combine this way: "[t]he motivation to combine the centralized class store with the method for configuring an Internet file system is apparent in that the LDAP directories are designed to manage network resources, and the O'Brien method comprises an X-Drive, (Fig. 13), which is a network resource." (emphasis added). This combination of O'Brien with Mishra is contrary to the guidance provided by the MPEP and the courts.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection and the rejection should be withdrawn. This rejection should be withdrawn and claims 2-7 depending from claim 1 should also be deemed patentable.

Applicants respectfully submit that this argument that O'Brien and Mishra are improperly combined is applicable for all of the Examiner's 35 U.S.C. § 103 rejections of the pending claims. Therefore this argument will not be repeated for each independent claim for the sake of brevity.

**Claim 8**

Independent claim 8 was also rejected under 35 U.S.C. § 103(a) as being anticipated by O'Brien and Mishra. This rejection is respectfully traversed. Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 8. Claim 8 cites,

8.    A method for file sharing, the method comprising:

sharing, by a first user, a file with a second user;

adding, by an application, the first user to a third attribute of the second user;

adding, by the application, the second user to a third attribute of the first user;

adding, by the application, a path of the shared file and a user name of the second user to a first attribute of the first user;

adding, by the application, the path of the shared file and a user name of the first user to a second attribute of the second user; and

making available, by the application, the first attribute through a folder of the second attribute, wherein the folder belongs to the second user.

The MPEP § 2142 provides:

> ... *The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the Examiner has not factually supported a prima facie case of obviousness and the rejection must be withdrawn.

### a.    Alone or Combined, the References Do Not Teach the Claimed Subject Matter

The O'Brien and Mishra patents cannot be applied to reject claim 8 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the <u>subject matter as a whole</u> would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

The O'Brien and Mishra references, either alone or combined, do not teach or suggest the elements of claim 8 and therefore do not render its subject matter obvious. Curiously, the Examiner used Mishra as the primary reference for establishing the rejection of claim 8 and used O'Brien for merely providing the motivation for the combination. (Paper 4, page 5, para. 13; paper 6, page 5, para. 14) The Examiner referenced the text at col. 19, lines 29-67 and col. 20, lines 1-40 of Mishra as support for rejecting all the elements of claim 8. The text located at the specified locations are claim 1-15 of Mishra. However, none of this language or elsewhere in

Mishra or O'Brien teach or suggest claim 8. For example, where does O'Brien or Mishra teach "adding, by the application, a path of the shared file and a user name of the second user to a first attribute of the first user?" Where does O'Brien or Mishra teach "adding, by the application, the path of the shared file and a user name of the first user to a second attribute of the second user?" Where does O'Brien or Mishra teach "making available, by the application, the first attribute through a folder of the second attribute, wherein the folder belongs to the second user?" Applicants can find none and the Examiner has not provided any guidance except by pointing to claims 1-15 of Mishra. Indeed, neither O'Brien nor Mishra teach the limitations of claim 8.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

### b.      Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

It may be seen that O'Brien, by providing a public folder and a private folder and using passwords for limiting file access, teaches away from the shared path, received path and friends attribute limitations of claim 8. Mishra, which teaches a class store schema, does not remedy O'Brien's deficiencies.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness. Thus, for this reason alone, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 8 should be withdrawn.

### Claim 25

Independent claim 25 was also rejected under 35 U.S.C. § 103(a) over O'Brien and Mishra. Applicants traverse this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 25. Claim 25 cites,

25. A system for configuring an internet file system, the system comprises:

a server configured with an application, wherein a user accesses the application and the application creates an internet file system for the user; and

a directory that stores a home folder of the user, wherein folders and files in the home folder are available at a root of the internet file system, wherein the application further provides a plurality of folders in a root of the home folder, and wherein the application further creates an auxiliary class containing a plurality of attributes.

The MPEP § 2142 provides:

> ... *The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a *prima facie* case of obviousness.

### Alone or Combined, the References Do Not Teach the Claimed Subject Matter

The O'Brien and Mishra patents cannot be applied to reject claim 25 under 35 U.S.C. § 103 because neither O'Brien nor Mishra teach providing "a directory that stores a home folder of the user, wherein folders and files in the home folder are available at a root of the internet file system, wherein the application further provides a plurality of folders in a root of the home folder, and wherein the application further creates an auxiliary class containing a plurality of attributes." Therefore, O'Brien and Mishra does not render the subject matter of claim 25 as a whole obvious.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

## Claim 28

Independent claim 28 was similarly rejected under 35 U.S.C. § 103(a) over O'Brien and Mishra. Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 28. Claim 28 cites,

> 28.　　A system for file sharing, the system comprises:
> means for sharing, by a first user, a file with a second user;
> means for adding, by an application, the first user to a third attribute of the second user;
> means for adding, by the application, the second user to a third attribute of the first user;
> means for adding, by the application, a path of the shared file and a user name of the second user to a first attribute of the first user;
> means for adding, by the application, the path of the shared file and a user name of the first user to a second attribute of the second user; and
> means for making available, by the application, the first attribute through a folder of the second attribute, wherein the folder belongs to the second user.

It is submitted that, in the present case, the examiner has not supported a prima facie case of obviousness to properly reject claim 28.

### Alone or Combined, the References Do Not Teach the Claimed Subject Matter

35 U.S.C. § 103 provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. The Examiner again cited generally to claims 1-15 of Mishra as providing teaching of claim 28. However, there is no reasonable way to read Mishra's claims to render claim 28 obvious. Since O'Brien and Mishra, alone or combined, do not teach "means for adding...the first user to a third attribute of the second user; means for adding...the second user to a third attribute of the first user; means for adding...a path of the shared file and a user name

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of the second user to a first attribute of the first user; and means for making available...the first attribute through a folder of the second attribute..." as is claimed in claim 28, it is impossible to render the subject matter of claim 28 as a whole obvious.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**Claim 32**

Independent claim 32 was also rejected under 35 U.S.C. § 103(a) over the O'Brien-Mishra combination. This rejection is respectfully traversed. Claim 32 cites,

> 32.     A directory comprises:
> a user object;
> a home folder of the user, wherein the home folder is an attribute of the user object;
> an auxiliary class attached to the user object when files are shared with the user;
> a community folder that includes topics of interest to the user; and
> a group object associated with each topic of interest.

**Alone or Combined, the References Do Not Teach the Claimed Subject Matter**

The MPEP § 2142 provides that the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." Applicants respectfully submit that the Examiner has failed to do so. The Examiner asserted generally that Mishra, in col. 4, line 63 to col. 6, line 13 disclosed the elements of claim 32, yet the Examiner does not provide any additional guidance as to what she thinks are the claimed limitations in Mishra. The Examiner characterized the teachings of Mishra in the above-cited locations as "the implementation of a class store in a group policy for purposes of application management utilizing the Windows NT Active Directory and a LDAP class store schema," and thus it naturally follows that Mishra teaches claim 32. A close examination of both references makes it clear that neither O'Brien nor Mishra provide the teaching of, for example, "a community folder that includes topics of interest

to the user; and a group object associated with each topic of interest." This rejection should therefore be withdrawn.

Claim 33 depends from independent claim 32 and is therefore patentable for the same reasons as set forth above.

**Claim 34**

Independent claim 34 was also rejected under 35 U.S.C. § 103(a) over O'Brien and Mishra. This rejection is respectfully traversed. Claim 34 cites,

> 34.     A software application executable on a computer, the application comprising:
> creating a user internet file system;
> providing files in a root of a user's home folder; and
> creating an auxiliary class attached to an object of the user if the files are shared via the internet file system.

**Alone or Combined, the References Do Not Teach the Claimed Subject Matter**

The MPEP § 2142 provides that the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." Applicants respectfully submit that the Examiner has failed to do so. Although Mishra may teach, as the Examiner had characterized, "the implementation of a class store in a group policy for purposes of application management utilizing the Windows NT Active Directory and a LDAP class store schema," Mishra does not teach or suggest, for example, "creating an auxiliary class attached to an object of the user if the files are shared via the internet file system." Further, the combination of O'Brien and Mishra does not teach or suggest these limitations. This rejection should therefore be withdrawn.

## Issue 3.

The third issue before the Board is whether claims 4-7, 9, 10, 18, and 21-24 are unpatentable under 35 U.S.C. §103(a) over O'Brien and Mishra and further in view of Ferraiolo.

Independent claim 18 was rejected under 35 U.S.C. § 103(a) as being anticipated by O'Brien and Mishra, and further in view of Ferraiolo. Applicants traverse this rejection on the grounds that these references do not establish a *prima facie* case of obviousness with respect to claim 18. Claim 18 cites,

> 18.     A method for creating user objects in a directory, the method comprising:
>      if a user shares a folder with another user who is not registered with an application in the directory, creating a temporary user object with an email address as a name of the another user;
>      submitting, by the another user, a registration form;
>      determining, by a script, if the email address corresponds with the another user; and
>      if the email address corresponds with the another user, updating the temporary user object based on information provided in the registration form.

The MPEP § 2142 provides:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

Applicants respectfully submit that the Examiner has not factually supported a *prima facie* case of obviousness. As discussed above, O'Brien provides a database that may be searched for Internet-based files. Mishra provides an application deployment management system. However, the Examiner is misguided in using the Ferraiolo reference as a basis of this rejection.

### a.     Alone or Combined, the References Do Not Teach the Claimed Subject Matter

O'Brien, Mishra and the Ferraiolo references cannot be applied to reject claim 18 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time*

*the invention was made to a person having ordinary skill in the art*
*to which the subject matter pertains ... (Emphasis added)*

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since none of the references teach creating a temporary user object with an email address, submitting a registration form, determining if the email address corresponds with the another user, and updating the temporary user object as is claimed in claim 18, it is impossible to render the subject matter of claim 18 as a whole obvious, and the explicit terms of the statute cannot be met.

The Examiner referenced bottom of page 2 to top of page 3 of Ferraiolo which discussed discretionary access controls (DAC) in the rejection. The Ferraiolo reference provides that "DAC is an access control mechanism that permits system users to allow or disallow other users access to objects under their control...based on the identity of subjects and/or groups to which they belong. The controls are discretionary in the sense that a subject with a certain access permission is capable of passing that permission ...on to any other subject." (bottom of page 2 to top of page 3) Ferraiolo further states a the top of page 3 that, "[a] DAC mechanism allows users to grant or revoke access to any of the objects under their control without the intercession of a system administrator." DAC, as pointed out by the authors, is *fundamentally different* from a role-based access control policy (RBAC) because in RBAC, "users *cannot* pass access permission on to other users at their discretion." (Page 3, third full paragraph). However, in forming the rejection of claim 18, the Examiner then pointed to page 4 of the Ferraiolo reference that further discusses RBAC. By doing so, the Examiner is essentially citing contrary teachings to reject claim 18.

Even if we overlook the fact that the Examiner citied different and contrary teachings of DAC and RBAC, neither DAC nor RBAC teach the limitations of claim 18. Further, O'Brien and Mishra in combination with Ferraiolo also do not teach or suggest the claimed limitations.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**b . Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness**

It may be seen that O'Brien, by providing a database that stores the "metadata" associated with the files for searching purposes, Mishra, by providing a way to manage the deployment of applications for users or groups, and the Ferraiolo reference, by teaching role-based access or direct access methods, all teach away from the limitations of claim 18. None of these references teach "a user shar[ing] a folder with another user," but instead teach how to prevent unauthorized access in different ways. These references are therefore contrary to the claim in spirit or substance.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 18 under 35 U.S.C. §103 should be withdrawn.

Claims 21-24 depend from independent claim 18 and provide additional limitations thereto. Claims 21-24 are therefore also allowable for at least the reasons set forth above. Claims 4-7, 9, and 10 also rejected over O'Brien-Mishra-Ferraiolo should also be allowable for at least some of the reasons set forth above.

## CONCLUSION

Accordingly, it is respectfully submitted that the references alone or in combination does not disclose or suggest the subject matter of claims 1-34. Moreover, it is respectfully submitted that it is improper to combine the references because there is no motivation or suggestion for such combination to achieve the Applicants' claimed elements. The references also teach away
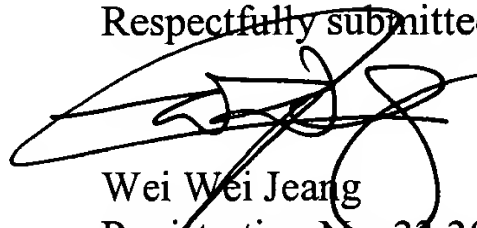
from the claim limitations and therefore are a *per se* demonstration of lack of *prima facie* obviousness.

For all of the foregoing reasons, it is respectfully submitted that claims 1-34 be allowed. A prompt notice to that effect is respectfully requested.

Respectfully submitted,

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APPENDIX

1.      A method for configuring an internet file system, the method comprising:

accessing, by a user, a server that is configured with an application;

creating, by the application, an internet file system for the user;

storing, by a directory, a home folder of the user, wherein folders and files in the home folder are available at a root of the internet file system;

providing, by the application, a first folder and a second folder in a root of the home folder, the first folder containing folders that represent folders and files that have been shared with the user, and the second folder containing objects of the user and communities that are of interest to the user; and

creating, by the application, an auxiliary class containing a first attribute, a second attribute, and a third attribute, wherein the first attribute is used to quickly find other users that the folders and the files in the home folder have been shared with, the second attribute is used to store names of the other users and a path of the folders and the files that have been shared with the user, and the third attribute is used to allow the user and other users with common interests to share folders and files of the common interest.

2.      The method of claim 1 further comprising accessing, by the user, the internet file system.

3.      The method of claim 1 further comprising attaching the auxiliary class to a user object when the folders and the files are shared with the user.

4.      The method of claim 1 further comprising enabling the user to modify granted rights to the shared folders and the shared files.

5.      The method of claim 1 further comprising enabling the user to disallow the sharing of the folders and the files.

6.    The method of claim 1 further comprising populating the first folder with the stored names of the other users and the path of the folders and the files that have been shared with the user.

7.    The method of claim 1 further comprising creating communities of users with common interests, wherein the communities are stored as groups in the directory and the users are members of the groups.

8.    A method for file sharing, the method comprising:

sharing, by a first user, a file with a second user;

adding, by an application, the first user to a third attribute of the second user;

adding, by the application, the second user to a third attribute of the first user;

adding, by the application, a path of the shared file and a user name of the second user to a first attribute of the first user;

adding, by the application, the path of the shared file and a user name of the first user to a second attribute of the second user; and

making available, by the application, the first attribute through a folder of the second attribute, wherein the folder belongs to the second user.

9.    The method of claim 8 further comprising, if the first user modifies rights to the first attribute, determining by the application which user the folder has been shared with and what rights the user has been granted.

10.    The method of claim 8 further comprising notifying the second user, by the application, that the file has been shared with the second user.

11.    The method of claim 8 further comprising placing, by the application, objects of the first user and the second user into a folder of the attribute that is located in an internet file system of the first user and in an internet file system of the second user.

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12.     The method of claim 11 further comprising sharing the objects by the first user and the second user.

13.     The method of claim 8 wherein the first attribute is a shared path attribute.

14.     The method of claim 8 wherein the second attribute is a received path attribute.

15.     The method of claim 8 wherein the third attribute is a friend attribute.

16.     The method of claim 8 wherein the first attribute, the second attribute, and the third attribute are located in a directory.

17.     The method of claim 8 wherein the first user has a second attribute and the second user has a first attribute.

18.     A method for creating user objects in a directory, the method comprising:

if a user shares a folder with another user who is not registered with an application in the directory, creating a temporary user object with an email address as a name of the another user;

submitting, by the another user, a registration form;

determining, by a script, if the email address corresponds with the another user; and

if the email address corresponds with the another user, updating the temporary user object based on information provided in the registration form.

19.     The method of claim 18 further comprising, if there is no corresponding user object, creating a new user object based on the information provided.

20.     The method of claim 18 further comprising monitoring, by the script, interests the another user has submitted in the registration form.

21.     The method of claim 20 further comprising associating each interest of the

another user with a group object in a container of the application.

22.     The method of claim 21 further comprising adding the another user as a member of each interest group.

23.     The method of claim 22 further comprising adding the each interest group to a list of friends of the another user.

24.     The method of claim 18 wherein the information includes at least one item from a group consisting of:

the email address;

a user name;

a password;

a first name;

a last name;

an address; and

interests.

25.     A system for configuring an internet file system, the system comprises:

a server configured with an application, wherein a user accesses the application and the application creates an internet file system for the user; and

a directory that stores a home folder of the user, wherein folders and files in the home folder are available at a root of the internet file system, wherein the application further provides a plurality of folders in a root of the home folder, and wherein the application further creates an auxiliary class containing a plurality of attributes.

26.     The system of claim 25 wherein the plurality of folders includes a first folder containing folders that represent folders and files that have been shared with the user, and a second folder containing objects of the user and communities that are of interest to the user.

27.    The system of claim 25 wherein the plurality of attributes includes a first attribute used to quickly find other users that the folders and the files in the home folder have been shared with, a second attribute used to store names of the other users and a path of the folders and the files that have been shared with the user, and a third attribute used to allow the user and other users with common interests to share folders and files of the common interest.

28.    A system for file sharing, the system comprises:

means for sharing, by a first user, a file with a second user;

means for adding, by an application, the first user to a third attribute of the second user;

means for adding, by the application, the second user to a third attribute of the first user;

means for adding, by the application, a path of the shared file and a user name of the second user to a first attribute of the first user;

means for adding, by the application, the path of the shared file and a user name of the first user to a second attribute of the second user; and

means for making available, by the application, the first attribute through a folder of the second attribute, wherein the folder belongs to the second user.

29.    A user internet file system comprises:

a received folder that contains folders representing files and folders that have been shared with a user and the names of those who shared the files and folders with the user; and

a friends folder that contains the user's objects and community folders that contain information that are of interest to the user.

30.    The file system of claim 29 further comprises a root similar to a home folder of the user.

31.    The file system of claim 30 wherein files and folders in the home folder are available at the root of the file system.

32.     A directory comprises:

a user object;

a home folder of the user, wherein the home folder is an attribute of the user object;

an auxiliary class attached to the user object when files are shared with the user;

a community folder that includes topics of interest to the user; and

a group object associated with each topic of interest.

33.     The directory of claim 32 wherein the auxiliary class is attached to the user object when the user shares files with other users.

34.     A software application executable on a computer, the application comprising:

creating a user internet file system;

providing files in a root of a user's home folder; and

creating an auxiliary class attached to an object of the user if the files are shared via the internet file system.